

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eiichi Nakano, et al.

Serial No.: 09/864,301

Filed: May 25, 2001

For: CALCULATION SERVICE PROVIDING SYSTEM

Honorable Commissioner of Patents
Alexandria, VA 22313-1450



Group Art Unit: 2157

Examiner: Coffy, Emmanuel

AF/ERW
2157

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Sir:

Withdrawal of the finality of the Office Action of March 31, 2005 is respectfully requested.

The first Office Action, dated September 9, 2004, rejected all the claims under 35 U.S.C. §103(a) on prior art and rejected claims 4 and 10 under 35 U.S.C. §112, second paragraph. In a responding Amendment filed November 29, 2004, various claims were amended. Both before and after that Amendment, claim 1 and claim 7 recited "a calculation service". No comment with regard to this term was included in the September 9, 2004 Office Action, and no change was made to that term in the November 29, 2004 Amendment.

The March 31, 2005 Office Action rejects the claims on prior art and additionally rejects claims 1 and 7 under 35 U.S.C. §112 as indefinite, with the contention that "calculation service" is undefined. *Assuming this rejection to be valid*, it was just as applicable in the first Office Action as in the second Office Action. Thus, this is a new ground of rejection not necessitated by Applicant's amendment.

MPEP §707.07(g) states:

"Piecemeal prosecution should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available". (Emphasis added.)

MPEP §706.07(a) states:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” (Emphasis added.)

37 C.F.R. §1.97(c) relates to information disclosure statements filed more than three months after the filing date of the application and after a first Office Action. The 35 U.S.C. §112 rejection is not related to any information disclosure statement.

The Office Action of March 31, 2005 violates both of these MPEP sections. Clearly, if claims 1 and 7 as amended in the Amendment of November 29, 2004 were unclear, and so subject to rejection under 35 U.S.C. §112, then those claims were unclear, and so subject to rejection under 35 U.S.C. §112, prior to that Amendment. In such event, not rejecting the claims on that basis in the September 9, 2004 Office Action, but doing so in the March 31, 2005 Office Action constitutes piecemeal prosecution.

Clearly, also, rejecting claims 1 and 7 in the Office Action of March 31, 2005 introduces a new ground of rejection that was neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement.

Accordingly, the March 31, 2005 Office Action should not have been a final rejection, and so withdrawal of the finality of the rejection is requested.

As stated in the Record of Telephone Interview filed March 1, 2005, during the February 24, 2005 telephone interview with Examiner Emmanuel Coffy the undersigned attorney pointed out to the Examiner that such a rejection under 35 U.S.C. 112 would be a new ground of rejection, barring a Office Action. In the March 31, 2005 Office Action,

Serial No. 09/864,301
Docket No. F-11150
YAS.030

Examiner Coffy contends that the addition of new claims 13-18 necessitated a new search.

Assuming that claims 13-18 have necessitated a new search, that does not make it proper for the March 31, 2005 Office Action to be a final rejection. The rejection of claims 1 and 7 under 35 U.S.C. §112 is a new ground of rejection not necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement.

Thus, the Office Action should not have been a final rejection. Therefore, withdrawal of the finality of the Office Action is in order and is respectfully requested.

It is also requested that the period for response be restarted with the withdrawal of the finality of the Office Action.

A response to the substance of the Office Action will be filed in due course.

Applicant is entitled to the opportunity to amend the claims, if necessary, to any extent appropriate in order to overcome this new ground of rejection, and so withdrawal of the finality of the rejection is proper.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR §1.136. The Commissioner is authorized to charge any deficiency in fees, including extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date:

April 7, 2005

Respectfully Submitted,



James N. Dresser, Esq.

Registration No. 22,973

McGinn & Gibb, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254